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EXAMINER

ALBERTALLI, BRIAN LOUIS

ART UNIT	PAPER NUMBER
2655	

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/000,111

Applicant(s)

ROECK, JUERGEN

Examiner

Brian L. Albertalli

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
 - On page 2, "Background of the Invention" section, line 1, "multipl" should be – multiple--.
 - On page 6, line 2, "13x" should be –138--.
 - On page 6, line 3, "13x" should be –138--.Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
3. Claims 7, 14, and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In regard to claims 7, 14, and 21, claims 7, 14, and 21 depend from parent claims 1, 8, and 15, respectively. Claims 1, 8, and 15 require that "elements" are parsed and modified "according to a natural language rule and limitation set". The claimed "elements" include "information blocks (see claims 5, 12, and 19), and these

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"information blocks" include "text, email, HTML, graphics images, video, and audio" (emphasis added). A single information block, therefore, is required to contain each of the media elements set forth in claims 7, 14, and 21 (namely, text, email, HTML, graphics images, video, and audio).

While it is doubtful that an "information element" that contained each of the media elements of claims 7, 14, and 21, could be "modified" to provide a "cohesive composite communication", the specification further provides no indication as to how graphics images, video, and audio could be "parsed" according to a natural language rule and limitation set. Firstly, graphic images, video, and audio do not necessarily contain any natural language information that could be "parsed" (in the natural language sense). Secondly, even if there were natural language information in the graphic images, video, or audio, some type of means for extracting the natural language information would be required, such as optical character recognition (in the case of graphic images), speech recognition (in the case of audio), or both (in the case of video).

Still further, in the case of HTML and email these media types contain an abundance of information that could not reasonably be "parsed according to a natural language rule and limitation set" without substantial modification. Natural language rule and limitation sets generally only provide information that relates to natural language, such as part of speech, context, allowable word sequences, etc. HTML is replete with information such as tags as well as punctuation that is not encountered in natural language. Similarly, email contains information, such as message headers, that could not be handled by a natural language rule and limitation set.

Lacking any description in the specification as to how email, HTML, graphic images, video and audio are “parsed and modified according to a natural language rule and limitation set”, claims 7, 14, and 21 fail to comply with the enablement requirement.

For the purposes of examination, claims 7, 14, and 21 have been interpreted in the alternative, (i.e. “wherein the information blocks include text, email, HTML, graphics images, video, or audio”).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 8, and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “transitional zones” is not a well known or widely used term in the art, and the specification provides no definition, implied or otherwise, that one of ordinary skill in the art could use to determine what is encompassed by a “transitional zone” of an “element”. This term is more obscured by the fact that the claimed “elements” can apparently be any type of media (see, for example, page 5, 1st and 2nd paragraph). So, it is unclear what would comprise the “transitional zone” of an element of text (a few letters, several sentences, several pages?) or graphics images (the top and bottom, the sides?) or video (a few frames, several minutes?) or audio (several samples?) or any other media that may comprise the claimed “elements”.

Claims 1, 8, and 15 are therefore indefinite.

For the purposes of examination any modification of any part of an "element" has been interpreted herein as equivalent to "modifying transitional zones".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 4-7, 9, 10, and 11-14 rejected under 35 U.S.C. 102(b) as being anticipated by Holloran et al. (U.S. Patent 5,369,573).

In regard to claims 1 and 8, Holloran et al. disclose a method and machine readable medium comprising:

providing for receiving a list of required elements (Fig. 1, the user enters data into a step data table 102, which contains all of the elements required to generate the desired communication, column 4, lines 18-26 and column 5, lines 34-39);

providing for adding elements from the list to a communication until an end of the list is reached (all of the data in step data table 102 is concatenated to generate a communication, column 4, lines 42-51);

providing for parsing and modifying the elements according to a natural language rule and limitation set, wherein parsing and modifying includes modifying transitional zones and fusing the elements into a cohesive composite communication (concatenation rules are used in combining the elements, the concatenation rules being

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natural language rules and limitations such as what form of the verb is allowed, punctuation, etc., column 6, lines 19-36; furthermore, the elements are modified to ensure they meet the set of rules defined by the syntax, column 5, lines 43-45 and column 6, lines 37-43); and

providing for dispatching the communication to media channels (the steps are then added to documents, which are sent to an output device, column 7, lines 19-28; any output of a communication is equivalent to “dispatching” to “media channels”).

In regard to claims 2 and 9, Holloran et al. disclose parsing and modifying includes using input from the list (elements from data table 102 are parsed and modified to ensure they meet the rules defined by the syntax, column 5, lines 46-51).

In regard to claims 4 and 11, Holloran et al. disclose the elements include an action item result in the list (the elements define a step in a procedure that one is to follow, column 4, lines 18-26).

In regard to claims 5, 7, 12, and 14, Holloran et al. disclose the elements include information blocks which include text (as defined by the specification, an “information block” is any type of “multimedia information type”, the elements in data table 102 are text, and thus, “information blocks”, see Fig. 1).

In regard to claims 6 and 13, Holloran et al. disclose the information blocks are retrieved from at least one database or repository (the elements are retrieved from data table 102, a data table is equivalent to a "database or a repository", column 5, lines 46-51).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3, 10, and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holloran et al.

In regard to claims 3, 10, and 15, Holloran et al. disclose an apparatus comprising:

a composer to receive a list of required elements and add elements from the list to a communication until an end of the list is reached (Fig. 1, the user enters data into a step data table 102, which contains all of the elements required to generate the desired communication, column 4, lines 18-26 and column 5, lines 34-39; all of the data in step data table 102 is concatenated to generate a communication, column 4, lines 42-51);

a natural language processor coupled with the composer, the natural language processor to parse and modify the elements according to a natural language rule and limitation set, and thereby to modify transitional zones and fuse the elements into a

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cohesive composite communication (concatenation rules are used in combining the elements, the concatenation rules being natural language rules and limitations such as what form of the verb is allowed, punctuation, etc., column 6, lines 19-36; furthermore, the elements are modified to ensure they meet the set of rules defined by the syntax, column 5, lines 43-45 and column 6, lines 37-43); and

an output device coupled with the natural language processor, the output device to dispatch the communication to media channels (the steps are then added to documents, which are sent to an output device, column 7, lines 19-28; any output of a communication is equivalent to "dispatching" to "media channels").

Holloran et al. do not disclose that the dispatch of the communication is performed through a "mailer or responder" (which has been interpreted herein as email or the like).

Official notice is taken that it is notoriously well known in the art to "dispatch communications" with a "mailer or responder", so that the communication can be reviewed by another person, or the communication can be distributed to the audience for which it was intended. Especially in the case of email, this provides a fast, generally free, and efficient (in that a physical copy of the communication does not have to be created) means for dispatching communications. Further, with regard to claims 3, 10, and 17, "embedding" content from the list into a responder or mailer has been interpreted herein as including content that was in the list in a message that will be sent by the mailer.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Holloran et al. to dispatch the completed communications over to media channels through a mailer or responder, so that the communication can be reviewed by another person, or the communication can be distributed to the audience for which it was intended.

The limitations of claims 16 and 18-21 are the same as claims 2, 4-7, 9, and 11-14, above, and thus are rejected for the same reasons.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Carbonell et al. (U.S. Patent 5,995,920) disclose a system for generating documents from separate elements including graphics, tables, text, audio, and video that ensures the document is free of grammatical errors and ambiguity. Isadore-Barreca (U.S. Patent 5,590,262) and Ohanian (U.S. Patent 6,161,115) disclose systems for merging separate video and audio elements. Cornelia et al. (U.S. Patent 6,065,026) disclose a system for generating consistent documents using elements from a plurality of authors. Elliot (U.S. Patent 6,651,219) discloses a system that generates grammatically correct financial reports from a plurality of provided financial data elements. Zamora (U.S. Patent 5,113,342) and Skiena et al. (U.S. Patent 5,960,385) disclose various natural language processing systems.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian L. Albertalli whose telephone number is (571) 272-7616. The examiner can normally be reached on Mon - Fri, 8:00 AM - 5:30 PM, every second Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on (571) 272-7582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BLA 7/27/05


SUSAN MCFADDEN
PRIMARY EXAMINER